

Remarks

This amendment responds to the official action of March 27, 2009.

Drawings

In the official action, objections were made to the drawings under 37 C.F.R. §1.183(a), because aspects of claims 10 and 12 were considered to lack appropriate illustration in the drawings. Claims 10 and 12 also were rejected under 35 U.S.C. §112 based on alleged lack of a written description of the subject matter claimed.

Claims 10 and 12 have now been canceled, without prejudice, obviating these objections and rejections.

Definiteness

Claims 1-14 were rejected as indefinite due to the use of certain terms or phrases that were considered vague, or not associated in the disclosure with specific structural features. These terms are "holder" and "unrecognizable as a shower head mounting" in claim 1, and "disk-shaped" in claim 14.

Claim 1 has been amended to more particularly and distinctly define the subject matter of the invention and to better distinguish over the prior art of record. Claim 1 incorporates the subject matter of original claims 1-6. The "holder" as claimed is the part that attaches to the wall and has a pair of jaws that engage on diametrically opposite sides of a housing of the shower head.

The phrase "unrecognizable as a shower head mounting" has been canceled, without prejudice.

Applicant requests reconsideration and withdrawal of the objection to the phrase "disk-shaped." The terms "disk" and "shaped" are well understood and are used in the disclosure consistently with their dictionary definitions. A disk (or disc) is a thin circular object. See *Merriam Webster's Collegiate Dictionary*, 11th Ed., p. 360. "Disk-shaped" refers to the characteristic of having a thin circular shape.

The official action at paragraph 6 begins a further rejection of claim 14 but states no grounds. Applicant requests that the rejection be withdrawn as not in compliance with 35 U.S.C. §132, and that if a further rejection of the claims should be made under 35 U.S.C. §112, second paragraph, that such rejection be made non-final.

Design-Utility Double Patenting

Claims 1-14 were rejected on grounds of obviousness-type double patenting over US Pat. Des. 492,004 – Haug. Reconsideration is requested.

The rejection is based on a conclusion that the '004 Haug design patent claim and the claims of the present application are the same, at least to the extent that any differences are obvious. However, the design patent claims the ornamental design shown in the drawings, being thereby based substantially only on the drawings and being directed to aspects of ornamentation. Thus there is no basis for comparison against a list of utility claims wherein the invention is defined by claim limitations in successive degrees of detail, in written form, and having limitations that do not relate to ornamentation, and instead concern structure and function as opposed to ornamentation, in a basic sense.

An obviousness type double patenting rejection in a pending application may be appropriate when the claims of the pending application so resemble the claims of the previous patent that the same invention is encompassed, within a scope of variations that according to grounds articulated in the rejection are shown to have been obvious. The rule is based on a public policy that obtaining a second patent should not permit one to extend the monopoly of the first patent, namely the exclusive rights in the same invention defined by the claims. In the case of utility versus design inventions, different statutory categories of inventions are claimed, i.e., an article of manufacture having a stated structural configuration in a utility application or patent, regardless of ornament, versus the ornamental features of a useful article in a design application or patent, regardless of function.

MPEP 804 provides that it is conceivable that the same invention might be the subject of a design and a utility application in an appropriate situation, but also states that such a situation is rare. The situation is rare because it is unusual that the claims of a utility patent or application will concern matters of ornamentation as opposed to structure and function, namely the subject matter that is appropriately encompassed in a design patent or utility application, respectively. In the present case, examination of the facts and the law show that a double patenting rejection is not warranted.

According to MPEP 804, double patenting may conceivably be raised where an applicant has filed a utility patent application and a design patent application. The same double patenting principles and criteria that might be applied in utility-utility situations are also to be applied to utility-design situations. Thus the same invention, within a range of variations that are shown to have been obvious for articulated reasons, must be claimed in both the utility and the design case. MPEP 804 cites *Carman Industries Inc. v. Wahl*, 724 F.2d 932, 220 USPQ 481 (Fed. Cir. 1983), wherein US Pat. 3,261,508 was held NOT subject to rejection for double patenting over US Pat. Des. 202,068.

In *Carman Industries*, the court sought to deal with the illogic of a conclusion that a design patent and a utility patent, which by definition are directed to different statutory categories, could claim the same invention. This was necessary because a CCPA case had been cited as precedent for such a conclusion. The Court of Appeals for the Federal Circuit resolved the issue by adopting the test applied by the Third Circuit Court of Appeals in *Wahl v. Rexnord, Inc.*, 481 F.Supp. 573, 203 USPQ 838 (D. NJ 1979), *rev'd*, 624 F.2d 1169, 206 USPQ 865 (3d Cir. 1980). The test whether double patenting exists between a utility and a design patent or application is whether the two patent or application claims "cross-read," i.e., claim the same subject matter:

To say that patents cross-read means that a device embodying the patentable design of the design patent **must** infringe the utility patent; *and* that a device embodying the patentable claims of the utility patent **must** infringe the design patent. * * * [Emphasis in original.]
 See, 624 F.2d at 1179, 206 USPQ at 871.

The present application has claims that concern matters of structure and function. The cited design patent has a claim that concerns an ornamental design. It is

plain that the claims of the present utility application could be infringed by a product that is not within the scope of the claimed design. Thus the claims of the design and utility do not cross-read.

The issue of obviousness-type double patenting can admit of variations that are shown to have been obvious (by an articulated *Graham v. John Deere* analysis of the respective claims). However, even given the possibility of variations that are considered obvious, there is no basis to conclude that the design patent claim must be infringed by practicing the various claims of the utility patent, and vice versa. Therefore, according to the precedent cited above, the rejection for obviousness-type double patenting is unwarranted and must be withdrawn.

The often-quoted standard for determining the scope of a design patent claim, is from *Gorham Co. v. White*, 81 U.S. 511, 14 Wall. 511 (1871):

We hold, therefore, that if, in the eye of an ordinary observer, giving such attention as a purchaser usually gives, two designs are substantially the same, if the resemblance is such as to deceive such an observer, inducing him to purchase one supposing it to be the other, the first one patented is infringed by the other.

The scope of the utility patent claims is not commensurate with the scope of the design claim, and as such there is no basis to conclude that the claims cross-read on one another. An ordinary purchaser who compared the single design shown in the design drawings against the range of designs within the scope of the utility claims would be confronted with various designs that are ornamentally different from the single design shown in the design drawings.

A simple test of this fact is found in the embodiment illustrated in the drawings of the present utility patent application. The embodiment illustrated in the drawings is indisputably within the scope of the pending utility patent claims. Applying *Gorham Co. v. White*, there is no reason to conclude that an ordinary observer, giving such attention as a purchaser usually gives, would find the illustrated utility patent embodiment to be substantially the same as the embodiment in the design patent. According to *Gorham Co. v. White*, the necessary degree of resemblance is resemblance sufficient to deceive

the ordinary observer into purchasing the product in the utility illustration, supposing it to be the one shown in the design patent. There is no basis articulated on the record to justify such a conclusion. The claims of the utility and design cases are not for the same invention or an obvious variant, and there is no basis to maintain the rejection for obviousness-type double patenting under the criteria set forth in the MPEP and in the precedent of the courts.

It may be that the article shown in the design patent is within the scope of the utility patent application claims. That is only half of the test. The other half is that products that infringe the utility patent claims **must** infringe the design patent. And they do not. Under the Manual of Patent Examining Procedure and the law as stated by the Court of Appeals for the Federal Circuit, the rejection on grounds of double patenting is unwarranted and must be withdrawn.

Prior Art

Claim 1 has been amended to incorporate the subject matter of previous claims 1-6. Claims 1-14 were rejected in the official action as allegedly anticipated by three prior art references cited under 35 U.S.C. §§102(b) or 102(e), namely US 1,078,283 – Hilfiker; US 4,091,998 – Peterson; or US Provisional application 60/517,683 – Lev. the prior art. Reconsideration is requested.

Regarding US 1,078,283 – Hilfiker, the cited reference discloses a manual grip structure for a showerhead and fails to teach or remotely to suggest a wall mounting whereby a hand-shower head can be placed in a wall mounting or alternatively removed from the wall mounting and directed manually.

Hilfiker does not disclose a wall mounting for a showerhead as defined in amended claim 1. The reference numeral 13 in Hilfiker refers to the two manual grip parts of the device, i.e., parts of a handle that is non-detachably affixed to the spraying element of the shower. See the right-hand column of the first page of the Hilfiker specification, at the last paragraph beginning on line 92. The two cylindrical grip parts 13 reside on opposite sides of a flexible hose that can be pinched off by compressing

the hose between the grip parts 13. For this purpose, the grips 13 are connected by a continuous strip of round wire 5 passing around the showerhead, which functions like a return spring to oppose inward movement of grip parts 13 resulting in compression of the hose 15.

There is no teaching in Hilfiker about wall mounting. There is no teaching of engaging and releasing a hand shower housing from any structure. The spray portion in Hilfiker is not disclosed as separable or as useful apart from the handles 13 and round wire 5. The handles are required if there is to be a manual grip in the reference to enable the device to be manipulated. The handles function not only as valve means (by controllably pinching off the hose), but also manually to aim the direction of the spray.

Claim 1 as amended recites a wall mounting and a shower that is held by an interference fit and can be withdrawn, whereupon the shower remains operational, as a manual hand shower when withdrawn. This subject matter is not disclosed or suggested in Hilfiker. Applicant requests reconsideration and withdrawal of the rejection under 35 U.S.C. §102(b).

The claims were alternatively rejected as anticipated by US 4,091,998 – Peterson. Reconsideration is requested. As plainly shown at Fig. 1 and as taught by Peterson, opposed jaws or arms 73, 74 serve to hold the spraying apparatus when not in manual use, by engaging a hand grip, not the housing. The device does not engage the shower head housing.

Furthermore, Peterson fails to disclose or suggest a holder that is attachable to a wall as claimed. The Peterson holder is mounted on the end of the pipe fitting 16 by which the water line emerges from the wall. Peterson replaces a fixed shower head with a hose coupled showerhead whose handle or grip can be affixed to the water line, but does not disclose the invention defined by claim 1.

A rejection under 35 U.S.C. §102 requires that all the aspects stated in a claim be found together in the prior art in the same configuration as claimed. A rejection that renames elements in the prior art using terms in the claims is not a sufficient rejection

because the prior art in such as case does not disclose the elements of the claim in the same configuration as claimed, i.e., does not disclose the invention claimed as a whole. The prior art cited fails to disclose applicant's invention claimed as a whole.

Claims 1-14 were alternatively rejected over Provisional Application SN 60/517,683 - Lev, under 35 U.S.C. §102(e). Reconsideration is requested. This ground of rejection fails by virtue of the respective dates. The referenced application does not have a filing date prior to the date of invention by applicant as shown in the official record. The cited application does not qualify as prior art under 35 U.S.C. §102(e).

Under 35 U.S.C. §102(e), a claimed invention may be anticipated if it is disclosed in a US application filed by another before the invention of the subject matter by the applicant.

The Lev application cited as prior art is a provisional application filed November 6, 2003.

The present application is the national phase of an international PCT application. The international filing date is November 21, 2003, about two weeks after the Lev provisional application was filed. However a rejection under Section 102(e) is not properly made on the basis of respective filing dates. The issue is whether applicant's invention occurred prior to the reference filing date. Applicant's Paris Convention priority date is December 13, 2002, which evidences applicant's date of invention for the subject matter disclosed, and that date is eleven months earlier than the prior art reference. The Lev application is ineffective as a prior art reference under 35 U.S.C. §102(e). Applicant requests reconsideration and withdrawal of the rejection over Lev.

The rejection over Lev is insufficient under the law regardless of what Lev discloses. Moreover, Lev (which actually was granted in 2008 on an application filed in August 2004) does not disclose or suggest aspects that are particularly defined in applicant's claim 1. Lev discloses a wall mounting, but the hand shower head is not disk-shaped and is fixed in the wall mounting by a complementary shape that engages the grip as well as the shower head housing. The housing is not engaged at diametrically opposite points as claimed. This claimed structure is not merely an

accidental detail, but is particularly claimed and is one of the reasons that applicant's shower head can pivot to adjust the aim of the spray up and down independently of moving the mounting arm. The Lev shower head remains fixed relative to its mounting. It cannot be aimed except by manipulating the mounting.

For the foregoing reasons, none of the references cited as anticipating references under 35 U.S.C. §102 is sufficient to demonstrate anticipation under the law of the invention claimed as a whole. The prior art does not demonstrate the same structures, or even a similar approach to the mounting of a shower device in a mounting arm from which the shower device can be removed for manual aiming. The prior art does not anticipate the invention, and the differences between the invention and the prior art are such that one cannot conclude that the invention would have been obvious to a person of ordinary skill seeking to exploit predictable benefits from making modifications or combinations.

The claims as amended are definite. The invention claimed as a whole is not found in the prior art as properly regarded under the statutes and judicial precedents. The differences between the invention and the prior art are such that the subject matter claimed as a whole is not demonstrated to have been obvious.

Applicant requests reconsideration and allowance of the pending claims.

Respectfully submitted,

Date: June 26, 2009

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Docket No. D4700-00425
P 43743 WO/US